REMARKS

In the Office Action[1], the Examiner rejected claims 8-19 under 35 U.S.C. § 112, second paragraph; rejected claims 7-19 under 35 U.S.C. § 101; and rejected claims 7-19 and 33-36 under 35 U.S.C. § 102(e) as being anticipated by *Dalby et al.*, U.S. Patent No. 7,133,901 ("*Dalby*").

Claims 1-36 are pending in the application, of which claims 1-6, 20-32 are withdrawn, claims 7-19 and 33 are amended, and claims 7-19 and 33-36 are currently under examination.

I. Rejection of Claims 8-19 under 35 U.S.C. §112, second paragraph

The Office Action rejected claims 8-19 under 35 U.S.C. §112, second paragraph as having insufficient antecedent basis. Office Action, p. 2. The Office Action states "[t]he claims should recite, '[t]he method of claim . . . .'" *Id.* Applicants have amended claims 8-19 as suggested in the Office Action. Therefore, Applicants request the Examiner withdraw the rejection of claims 8-19 under 35 U.S.C. §112, second paragraph.

II. Rejection of Claims 7-19 under 35 U.S.C. §101

Applicants respectfully traverse the rejection of claims 7-19 under 35 U.S.C. § 101. However, in an effort to expedite prosecution, Applicants have amended claims 7-19 to recite, "[a] computer-implemented method for ...." Emphasis added. Claim 7

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

also recites "[a] characteristic hard-coded into a set of machine-readable instructions," which cannot be interpreted as being "performed without the use of a particular apparatus," as alleged by the Office Action. Office Action, p. 3. Therefore, claim 7 recites a statutory process. Claims 8-19 depend from claim 7. Therefore, the rejection of claims 7-19 under 35 U.S.C. § 101 is improper and should be withdrawn.

III. Rejection of Claims 7-19 and 33-36 under 35 U.S.C. §102(e)

Applicants respectfully traverse the rejection of claims 7-19 and 33-36 under 35 U.S.C. § 102(e) as anticipated by *Dalby*. In order to properly establish that *Dalby* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 7, recites a method including "receiving a **characteristic identifying a first subgroup** of selected participants in an enterprise, the **characteristic hard-coded** into a set of machine-readable instructions for segmenting communication recipients," (emphases added). *Dalby* fails to teach or suggest at least this element of claim 7.

The Office Action alleges *Dalby* meets this claim element, stating:

> receiving a characteristic ("role") identifying a first subgroup
> of selected participants (individual using user module,
> recipient, system administrator, employee, first group of

> matched recipients) in an enterprise (community), the
> characteristic hard-coded into a set of machine-readable
> instructions for segmenting communication recipients (see at
> least column 9, line 42 through column 10, line 26 and
> column 12, line 64 through column 13, line 1).

Office Action, p. 4. The Office Action fails to point out, and *Dalby* fails to teach or

suggest "hard-coding" the "characteristic . . . into a set of machine-readable

instructions," as recited in claim 7. Hard-coding refers to embedding input or

configuration data directly into the source code. *Dalby* discloses:

> The interface module 322 generates a graphical user
> interface that can be used to access the resources and/or
> services of community information system 300. This
> graphical user interface can be customized for each
> individual using user module 302a 302n, such as with
> individual specific information, i.e., name, email messages,
> class schedules, or the like. . . . At the user level,
> customization can be based upon the user's selection of
> various features, or can be based upon academic specific
> attributes or other characteristics of the user or recipient.
> Other such academic specific attributes can include, but are
> not limited to, those discussed with respect to the user
> accounts.

Dalby, col. 9, line 66 - col. 10, lines 19. Thus, *Darby* appears to disclose generating the

characteristic data within the program itself with the given input. *Dalby* teaches away

from "hard-coding" the "characteristic" as recited in claim 7. Therefore, *Dalby* fails to

teach or suggest "receiving a **characteristic identifying** a **first subgroup** of selected

participants in an enterprise, the **characteristic hard-coded** into a set of machine-

readable instructions for segmenting communication recipients," as recited in claim 7

(emphasis added). Claims 8-19 are also allowable at least due to their dependence

from claim 7.

Independent claim 33, although of a different scope from independent claim 7, includes similar recitations as independent claim 7. The cited reference does not teach each and every element of claim 33 for at least the reasons discussed above. Dependent claims 34-36 depend from independent claim 33 and, accordingly, the cited reference does not teach each and every element required by claims 34-36 due to their dependence. Therefore, the Examiner should withdraw the rejection of claims 7-19 and 33-36 under 35 U.S.C. § 102(e).

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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